



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No.4

Herbert B. Keil
KEIL & WEINKAUF
1101 Connecticut Avenue, N.W.
Washington, DC 20036

COPY MAILED

AUG 15 2002

In re Application of
Schelberger et al.
Application No. 10/044255
Filed: January 14, 2002
Attorney Docket No.: 48648DIV

ON PETITION **OFFICE OF PETITIONS**

This is a decision on the petition filed May 28, 2002, requesting in effect, that a Notice of Omitted Item(s) in a Nonprovisional Application ("Notice") mailed April 29, 2002 be withdrawn.

The application was filed on January 14, 2002. However, on April 29, 2002, Initial Patent Examination Division mailed the Notice stating that the application had been accorded a filing date of January 14, 2002 but pages 18 and 22 of the specification appeared to have been omitted.

In response, pages 18 and 22 of the specification were filed on May 28, 2002. The petition states the transmittal letter submitted on January 14, 2002 indicated the present application as a divisional application incorporated by reference the entire disclosure of a prior application.

The petition is dismissed.

The mailing of a "Notice of Omitted Items" permits the applicant to either: (1) promptly establish prior receipt in the PTO of the items at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted items in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the missing items were in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted items in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted items with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such items and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the "notice of Omitted Items" (37 CFR 1.181(f)).

In this case, petitioners neither assert that the missing pages were actually deposited in the PTO on January 14, 2002, with the other application papers nor request a later filing date.

Instead, applicants seek to add the pages of the specification to the present application on the basis that the pages are not new matter. However, no petition is necessary for that purpose. Additional pages of the specification may be entered by the primary examiner without a petition so long as the pages contain no new matter. See MPEP 608.02(a).

MPEP 201.06© states that:

... an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

In view of the incorporation by reference of the prior application, pages 18 and 22 of the specification supplied on January 14, 2002, would not constitute new matter if they were part of the original disclosure of the prior application. Applicants' state that application No. 09/581,833 contains pages 18 and 22 of the specification referred to in the present application.

If applicants desire that pages 18 and 22 be added to the application, the appropriate procedure is by way of amendment requesting the entry of the pages. Any such amendment should be filed prior to the first action on the merits and will be considered by the primary examiner.

Accordingly, the petition is inappropriate and is subject to dismissal.

The petition fee will not be refunded, since the petition was not necessitated by any error on the part of the USPTO.

Obviously, in view of the incorporation by reference of the prior application, pages 18 and 22 of the specification is not new matter if it was a part of the disclosure of the prior application.

The application is being returned to the Office of Initial Patent Examination Division for further processing with a filing date of January 14, 2002 using the application papers received in the Office on that date.

Thereafter, the application will be forwarded to appropriate group art unit for consideration by the examiner of the petition filed May 28, 2002, as an amendment requesting the entry of pages 18 and 22 of the specification.

Telephone inquiries related to this decision may be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251.

Christina Partera Donnell for

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy